

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Yasuhiro Hidaka
Appl. No.: 10/595,488
Conf. No.: 1355
Filed: September 19, 2006
Title: PRINT-ORDERING SYSTEM AND METHOD
Art Unit: 1774
Examiner: Unknown
Docket No.: 112857-548

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT TRANSMITTAL LETTER

Sir:

Submitted herewith is an Information Disclosure Statement for consideration in the above-identified application. In accordance with the provisions of 37 C.F.R. 1.56, 37 C.F.R. 1.97, and 37 C.F.R. 1.98, Applicants request that a citation and examination of the references cited on the enclosed PTO-1449 form be made during the course of examination of the above-identified application for United States patent. Pursuant to 37 C.F.R. 1.98, copies of any cited foreign patent documents and non-patent documents are enclosed.

This Information Disclosure Statement is submitted:

- ☒ [X] Within three months of filing of a national application; within three months of the date of entry of the national stage as set forth in 37 C.F.R. §1.491 in an international application; before the mailing date of a first Office Action on the merits, or before the mailing of a first Office Action after the filing of a Request for Continued Examination.
- ☐ [] After the period specified above, but before the mailing date of a Final Action under 37 CFR 1.113, a Notice of Allowance under 37 CFR 1.311, or an Action that otherwise closes prosecution in the application and is accompanied by one of:
 - ☐ [] Payment of the fee set forth in 37 CFR 1.17(p); or
 - ☐ [] The certification specified in 37 CFR 1.97(e) follows.
- ☐ [] After the mailing date of a Final Action under 37 CFR 1.113, a Notice of Allowance under 37 CFR 1.311, or an Action that otherwise closes prosecution in the application and is accompanied by the fee set forth in 37 CFR 1.17(p) and the certification specified in 37 CFR 1.97(e) follows.

- ☐ The undersigned counsel for applicant(s) hereby certifies each item of information contained in the accompanying Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the Information Disclosure Statement.
- ☐ The undersigned counsel for applicant(s) hereby certifies that no item of information contained in the accompanying Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned, after making reasonable inquiry, no item of information contained in the accompanying Information Disclosure Statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the Information Disclosure Statement.
- ☒ A copy of a Search Report from a corresponding foreign patent application is enclosed.
- ☐ A check in the amount of \$180 to cover the required fee is enclosed.
- ☐ The Commissioner is hereby authorized to charge the amount of \$180 to cover the required fee to Deposit Account No. 02-1818.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 02-1818.

Enclosed herewith is a copy of a search report associated with corresponding Singapore patent application, No. 200602738-7. The search report issued on November 7, 2006, where references cited therein are identified in this Information Disclosure Statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

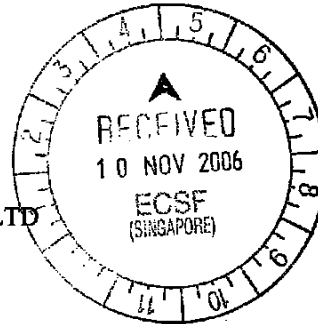
Thomas C. Basso
Reg. No. 46,541
Customer No. 26175

Dated: December 19, 2006

RF 240

In Reply Please Quote Our Reference

Your Ref : 1481SG1381/MHK/RN/RIN
Our Ref : 2006027387/061107/TMRMI/8608
Date : 07/11/2006
Writer's Direct Line : 63302748



ELLA CHEONG SPRUSON & FERGUSON (SINGAPORE) PTE LTD
P.O. BOX 1531
ROBINSON ROAD POST OFFICE
SINGAPORE 903031

Dear Sir,

Singapore Patent Application No.: 200602738-7
Title of invention: PRINT ORDERING SYSTEM AND METHOD
Applicant(s): SONY CORPORATION (JP)

INVITATION TO RESPOND TO WRITTEN OPINION

We forward with this letter a copy of the Search Report and Written Opinion drawn up by the Examiner in connection with your request for a Search and Examination Report.

You are invited to respond to the opinion by submitting:

- (a) Written submissions or arguments disagreeing with the Examiner's opinion and/or
- (b) An amendment of the specification of the application.

If you intend to respond, the response must be filed within 5 months from the date of this letter. You are also advised to inform us early if you do not intend to respond.

The Examiner will proceed to establish the Examination Report if no response is received by the end of the prescribed period.

If you have any further queries, please do not hesitate to contact the undersigned.

Thank you.

~~Yours faithfully,~~

ROZANA MISNI
for REGISTRAR OF PATENTS
SINGAPORE



AUSTRALIAN PATENT OFFICE

WRITTEN OPINION

Applicant's or agent's file reference 1481SG1381/MHK/RN/RIN		Date of mailing <i>day/month/year</i> 9 OCT 2006	
Application No. SG 200602738-7		Application Filing Date (<i>day/month/year</i>) 20 October 2004	Priority Date (<i>day/month/year</i>) 24 October 2003
International Patent Classification (IPC) (as indicated in the search report) Int. Cl. G06Q 10/00 (2006.01) G06F 3/12 (2006.01) Action Date: 22 September 2006			
Applicant SONY CORPORATION (JP)			

<p>1. This First written opinion consists of a total of 4 sheets.</p> <p>2. This opinion contains indications relating to the following items:</p> <ul style="list-style-type: none"> I <input checked="" type="checkbox"/> Basis of the opinion II <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability III <input type="checkbox"/> Lack of unity of invention IV <input checked="" type="checkbox"/> Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement V <input type="checkbox"/> Certain documents cited VI <input type="checkbox"/> Certain defects in the application VII <input checked="" type="checkbox"/> Certain observations on the application <p>3. This opinion is based upon the assumption that the priority claim is valid.</p> <p>4. The search report used was issued by the Australian Patent Office, and the date of completion is: 22 September 2006</p> <p>5. If no reply is filed, the examination report will be established on the basis of this opinion.</p> <p>6. The date by which the examination report will be established is: 24 January 2007</p>	
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Name and mailing address AUSTRALIAN PATENT OFFICE PO BOX 200, WODEN ACT 2606, AUSTRALIA E-mail address: pct@ipaustalia.gov.au Facsimile no. 61 2 62853929	Authorized Officer JULIA HU
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I. Basis of the opinion

1. This opinion has been drawn on the basis of:

☒ the application as originally filed.

☐ the description, pages , as originally filed,
 pages , filed with the request,
 pages , received on with the letter of

☐ the claims, pages , as originally filed,
 pages , filed with the request,
 pages , received on with the letter of

☐ the drawings, sheets/fig. , as originally filed,
 sheets/fig. , filed with the request,
 sheets/fig. , received on with the letter of

☐ the sequence listing part of the description:
 pages , as originally filed
 pages , filed with the demand
 pages , received on with the letter of

2. The amendments have resulted in the cancellation of: pages:
 sheets of drawings/figures No :

3. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box.

4. Additional observations, if necessary:

IV. Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims 1-18	YES
	Claims	NO
Inventive step (IS)	Claims	YES
	Claims 1-18	NO
Industrial applicability (IA)	Claims 1-18	YES
	Claims	NO

2. Citations and explanations

The following documents cited in the Search Report have been considered as relevant for the purposes of this opinion:

D1: US 2003/0053121 A1 (TAKEMOTO)

D2: US 5974401 A (ENOMOTO et al.)

D3: US 2004/0172440 A1 (NAKAJIMA et al.)

D4: US 2001/0003190 A1 (SHINDO et al.)

INVENTIVE STEP (IS) claims 1-18

D1 discloses a print-ordering system and method (Fig. 1, paragraphs [0012]-[0044])) where a customer, with an installed ordering software at a user terminal (11), can operate a multi-level image-selection process (Fig. 5), and place an order on a network server (21) via the Internet to print a selected (optimized/desired) image. This differs from the present invention as defined in claims 1-18 only in that the image-selection means is provided by the software installed on the user terminal, while the present claims define that the image-selection means is transmitted from the print-control means (centre server) to the user terminal. However, this difference is considered to be a trivial technical variation which offers no advance over the prior art. Furthermore, the present approach, that is, an image for selection to be provided by a network server (rather than a user terminal), is a known technique used in the art, see for example, D3 discloses that image data can be shared by a peer group via network servers (items 30, 50 in Fig. 1); D4 discloses that images and templates can be stored in a network server (Fig. 1), and later be retrieved from a separate terminal (such as a print service supply device PM1) for the customer to select and place an order. Therefore, claims 1-18 at least lack an inventive step when compared with D1 in view of any of D3 or D4.

D2 (see column 5 line 66 – column 9 line 8) also discloses all of the features of the present claims except that it does not explicitly disclose details of image correction though briefly touches on the topic (see column 6 lines 33-36). However, each of D1 (Fig. 5) and D3 (Figs. 4, 14) clearly teaches the image manipulation process, therefore it would have been obvious for a person skilled in the art to combine the teaching of D2 with either of D1 or D3 to fulfil all the functions of the instant invention. Also, D2 fails to disclose that the image-selection means is transmitted from the print-control means (centre server) to the user terminal, however, as discussed above, this represents a mere workshop variation which does not involve an inventive step.

VII. Certain observations on the application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

Claim 1 is not clear because there is no antecedent to *the image-processing-mode-selection image(s)* (lines 10-11).

The same objection applies to claims 7 and 13.



The claimed invention is patentable according to Section 13(2); or



The claimed invention is unpatentable according to Section 13(2) because:

AUSTRALIAN PATENT OFFICE

SEARCH REPORT

Applicant's or agent's file reference 1481SG1381/MHK/RN/RIN		
Application No. SG 200602738-7	Application Filing Date (day/month/year) 20 October 2004	(Earliest) Priority Date (day/month/year) 24 October 2003
Applicant SONY CORPORATION (JP)		

This search report consists of a total of 4 sheets.

☒ It is also accompanied by a copy of each prior art document cited in this report.

1. ☐ Certain claims were found unsearchable (See Box I)
2. ☐ Unity of invention is lacking (See Box II)
3. ☐ The application contains disclosure of a nucleotide and/or amino acid sequence listing and the search was carried out on the basis of the sequence listing
☐ filed with the application
☐ furnished by the applicant separately from the application,
☐ but not accompanied by a statement to the effect that it did not include matter going beyond the disclosure in application as filed
4. With regard to the title, ☒ the text is approved as submitted by the applicant.
☐ the text has been established by this Office to read as follows:

TELE NO 98/00097 98/01
5. With regard to the abstract, ☒ the text is approved as submitted by the applicant
☐ the text has been established by this Office as it appears in Box III
6. The figure of the drawings to be published with the abstract is Figure No. 1
☒ as suggested by the applicant.
☐ because the applicant failed to suggest a figure
☐ because this figure better characterises the invention
☐ None of the figures

A. CLASSIFICATION OF SUBJECT MATTER

According to International Patent Classification (IPC)

Int. Cl.

G06Q 10/00 (2006.01) G06F 3/12 (2006.01)
B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the search (name of data base and, where practicable, search terms used)

DWPI, keywords: print-order, print (2D) (order, deliver, service); network, internet, online, upload; (user, customer, client) (s) (select, set, cutomi, prefer, desired, favo?rite, optim); image; stor (s) (server, process, control)

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
Y	US 2003/0053121 A1 (TAKEMOTO) 20 March 2003 See the entire document in particular paragraphs [0012]-[0044]	1-18
Y	US 5974401 A (ENOMOTO et al.) 26 October 1999 See the entire document in particular column 5 line 66 – column 9 line 8	1-18
Y	US 2004/0172440 A1 (NAKAJIMA et al.) 2 September 2004 See paragraphs [0054]-[0064] & [0099]-[0110]; Figs, 1, 4, 14	1-18

☒ Further documents are listed in the continuation of Box C

☒ See patent family annex

* Special categories of cited documents:	
"A" document defining the general state of the art which is not considered to be of particular relevance	"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
"E" earlier application or patent but published on or after the international filing date	"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
"O" document referring to an oral disclosure, use, exhibition or other means	"&" document member of the same patent family
"P" document published prior to the international filing date but later than the priority date claimed	

Date of submission of the request to the Australian Patent Office 10 July 2006	Date of completion of the search report 22 September 2006	Date of mailing of the search report 9 OCT 2006
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Name and mailing address AUSTRALIAN PATENT OFFICE PO BOX 200, WODEN ACT 2606, AUSTRALIA E-mail address: pct@ipaustralia.gov.au Facsimile No. 61 2 62853929	Authorised officer JULIA HU
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C (Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
Y	<p>US 2001/0003190 A1 (SHINDO et al.) 7 June 2001 Fig. 1; paragraphs [0057]-[0075] & [0244]-[0246]</p> <p>For the "Y" indications, US 2003/0053121 can be combined with either of US 2004/0172440 or US 2001/0003190 with regard to claims 1-18; US 5974401 can be combined with 2004/0172440, or combined with US 2003/0053121 and further with US 2001/0003190, with regard to claims 1-18.</p>	1-18

Patent Document Cited in Search Report				Patent Family Member	
US	2003053121	JP	2003067478		
US	5974401	JP	10078618		
US	2004172440	JP	2004259249		
US	2001003190	EP	1107569	JP	2001166390
Due to data integration issues this family listing may not include 10 digit Australian applications filed since May 2001.					
END OF ANNEX					